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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,331	08/04/2003	Alan J. Polito	064881-5005 US-03	6774

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WASHINGTON, DC 20005-2221

EXAMINER
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HINES, JANA A

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 11/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/634,331

Applicant(s)

POLITO ET AL.

Examiner

Ja-Na Hines

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 98,99 and 101-120 is/are pending in the application.
- 4a) Of the above claim(s) 107-116 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 98, 99, 101-106 and 117-120 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Amendment Entry***

1. The amendment entered September 7, 2006 has been entered. Claim 98 has been amended. Claims 1-97 and 100 have been cancelled. Claims 107-116 have been withdrawn from consideration. Claims 117-120 have been newly added. Claims 98, 99 and 101-106 are under consideration in this office action.

### ***Withdrawal of Objections***

2. The objection of claims 102-106 under 37 CFR 1.75(c), as being of improper is withdrawn in view of applicants' arguments.

### ***Response to Arguments***

3. Applicant's arguments filed September 7, 2006 have been fully considered but they are not persuasive.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The rejection of claims 98, 99 and 101-106 under 35 U.S.C. 102(b) as being anticipated by Zweig (US Patent 5,554,531) is maintained for reasons already of record.

Art Unit: 1645

The rejection was on the grounds that the apparatus of Zweig teaches an apparatus comprising a housing; an autostart means; heating element; and test strip.

Applicants' assert that Zweig lacks any recitation of an apparatus wherein the capacitance sensor senses a change in capacitance. Applicants assert that that the two plates made of conductive material can act as capacitor plates but does not disclose a mechanism for sensing capacitance change. However the instant claims do not disclose a mechanism for sensing capacitance change, therefore the argument is not persuasive. Applicants' arguments about the mechanism for sensing capacitance change are not persuasive, since there is no structural difference between spaced apart conductive plates which have the ability to measure either resistance or capacitance. There must be a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. Since the prior art structure is capable of performing the intended use, it meets the claim.

Zweig teaches a pair of spaced apart electrodes which allow for initial sample application to be detected. Zweig teaches two spaced apart plates composed of conductive material. Applicants' specification teaches a capacitor consists of two conducting plates which could be of any shape or size separated by an insulating material called a dielectric or dielectric layer. The conductive material of Zweig meets the limitations of a dielectric layer. The plates of Zweig have the same structure and can function to sense the addition of buffer or sample to the test strip. Therefore the plates of Zweig meet the limitations of the capacitor sensor of the instant application. Contrary to applicants' assertions, Zweig meets the limitations of the claims and applicants'

Art Unit: 1645

arguments are not persuasive because the prior art structure is capable of performing the intended use, thus it meets the claim. Therefore, applicants' assertions are not persuasive and the rejection is maintained.

### ***Double Patenting***

5. The rejection of claims 98-106 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent No.6,136,610 is maintained. It is noted that applicants intend to file a terminal disclaimer, however the rejection will be maintained until the terminal disclaimer is filed and found proper.

### ***New Grounds of Rejection***

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 119-120 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

Art Unit: 1645

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

Neither the specification nor originally presented claims provides support for an  
The apparatus further comprising a moving mechanism attached to the test strip that moves the test strip with respect to the optical sensor or the further comprising an infrared sensor that detects the insertion of the test strip into the receptacle.

Applicant points to pages 19-20 for support of claim 119. However the specification teaches that the moving mechanism is attached to the housing and not to the test strip, as instantly claimed. Applicants state that support for claim 120 is found at page 24, however the specification states that the infrared sensor detects insertion of the cartridge, not the test strip as is instantly claimed. Thus there is no support for the newly added claims. Thus applicant failed to specifically point to the identity or provide structural characteristics of an apparatus further comprising a moving mechanism attached to the test strip that moves the test strip with respect to the optical sensor or the further comprising an infrared sensor that detects the insertion of the test strip into the receptacle. There appears to be no teaching of the instantly claimed apparatus with the recited characteristics. Therefore, applicants must specifically point to page and line number support for the identity an apparatus further comprising a moving mechanism attached to the test strip that moves the test strip with respect to the optical sensor or the further comprising an infrared sensor that detects the insertion of the test strip into the receptacle as recited by the newly added amendments. Therefore, the new claims incorporate new matter and are accordingly rejected.

Art Unit: 1645

7. Claim 117 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 117 refers to the test strip when the test strip is in place. It is unclear what place is being referred to. Therefore the metes and bounds of the claim language are unclear. Appropriate clarification is required to overcome the rejection.

### ***Conclusion***

8. No claims allowed.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

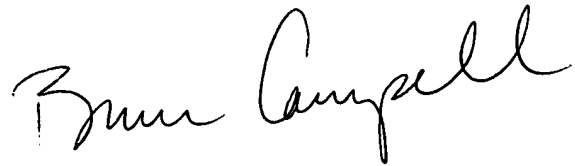
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ja-Na Hines whose telephone number is 571-272-0859. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Bruce Campell, can be reached on 571-272-0974. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ja-Na Hines  
November 7, 2006

A handwritten signature in black ink, appearing to read "Bruce Campell", written in a cursive style.

**BRUCE R. CAMPELL, PH.D  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600**